

REMARKS

In the present Amendment, claim 1 has been amended to clarify that the component (C) is a mixed organic solvent. As part of this amendment, the semicolon in element (C) of the claim after the words “a linear ketone”, which was amended to a comma in the Amendment filed October 7, 2005, has been changed back to a semicolon. Counsel sincerely regrets any confusion this may have caused. No new matter has been added, and entry of the Amendment is respectfully requested.

Upon entry of the Amendment, claims 1-3 and 6-17 will be pending.

In Paragraph No. 4 of the Action, claims 1, 8 and 11-17 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kodama et al (U.S. 2003/0017415 A1).

Applicants submit that this rejection should be withdrawn because Kodama et al ‘415 does not disclose or render obvious the positive resist composition of the present invention.

The Examiner relies on Examples IV-27 and IV-29 of Kodama et al.

Present claim 1 requires that the resin (A) must include a repeating unit represented by formula (AII). Neither resist composition IV-27 nor IV-29 of Kodama et al satisfies the present claims because neither resist composition includes a repeating unit within the scope of formula (AII) of present claim 1.

Another reason these examples of Kodama et al fail to anticipate the present claims is they do not satisfy element (C) of the present claims, which requires a specific mixed organic solvent. Neither Example IV-27 nor Example IV-29 of Kodama et al employs a mixed organic

solvent comprising (i) at least one solvent selected from the group consisting of a propylene glycol monoalkyl ether carboxylate, an alkyl lactate and a linear ketone; and (ii) a cyclic ketone.

In view of the above, reconsideration and withdrawal of the § 102(b) rejection based on Kodama et al '415 are respectfully requested.

In Paragraph No. 6 of the Action, claims 2-3, 6-7 and 9-10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kodama et al '415.

Applicants submit that this rejection should be withdrawn because Kodama et al '415 does not disclose or render obvious the positive resist composition of the present invention.

In this regard, neither resin 93 nor resin 94 of Kodama et al employed in Examples IV-23 and IV-24 of Kodama et al is within the scope of element (A) of the present claims. Specifically, neither resin 93 nor resin 94 includes a repeating unit within the scope of formula (AII) of present claim 1. With regard to the adamantyl group in resin 93, the Examiner will kindly note that it is bonded to the oxygen atom at a different position than the adamantyl group of formula (AII) of present claim 1. The resin 94 of Kodama et al does not even include an adamantyl group and is thus plainly outside the scope of claim 1 which requires that the resin (A) include a repeating unit of formula (AII).

The Examiner concedes that Examples IV-23 and IV-24 do not comprise the required combination of acid generators. However, she states, "based on the overall teachings of Kodama et al, specifically Examples IV-27 and IV-29, it would have been prima facie obvious to use a combination of a triarylsulfonium salt and a phenacylsulfonium salt as the acid generators."

This reasoning is unpersuasive because Examples IV-27 and IV-29 are outside the scope of the present invention, as explained above in response to the preceding rejection.

Further, there is no disclosure or suggestion in the cited examples of Kodama et al of the specific mixed solvent called for in the present claims. The Examiner's assertion that it would have been obvious to use any of the preferred solvents reflects an improper hindsight attempt to reconstruct the claimed invention.

In view of the above, reconsideration and withdrawal of the § 103(a) rejection of claims 2-3, 6-7 and 9-10 based on Kodama et al '415 are respectfully requested.

In Paragraph No. 7 of the Action, claims 1-3 and 6-17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Uetani et al (U.S. 2001/0044070 A1) in view of Kodama et al '415.

Applicants submit that this rejection should be withdrawn because Uetani et al '070 and Kodama et al '415 do not disclose or render obvious the positive resist composition of the present invention, either alone or in combination.

As explained at pages 2-4 of the Response filed April 24, 2006, Uetani et al and Kodama et al do not render the positive resist composition of the present invention prima facie obvious, and the present claims are patentable over their disclosures.

Even if a prima facie case of obviousness could be established based on Uetani et al and Kodama et al, Applicants submit herewith a Declaration Under 37 C.F.R. § 1.312 of Mr. Shinichi Kanna which shows that the present invention provides unexpectedly superior results in comparison to Example 1 of Uetani et al, the closest prior art. These superior results rebut any

prima facie case of obviousness and demonstrate the patentability of the present invention over Uetani et al and Kodama et al.

As explained in his Declaration, Mr. Kanna prepared and evaluated two resist compositions, designated Comparative Example a' and Example a, as seen in Table A at page 2 of the Declaration.

Comparative Example a' corresponds to a reproduction of Example 1 of Uetani et al. Example 1 of Uetani et al is believed to be the closest prior art example of record, to the resist composition of the present invention. Example a is the same as Comparative Example a', except that the photoacid generator (PAG) used in Example 1 of Uetani was replaced with the mixed photoacid generator I-21/III-2 (0.08/0.12)(parts) of Example IV-27 of Kodama et al. Example a is an embodiment of the present invention. As noted, it is Applicants' position that it would not have been prima facie obvious to substitute Kodama et al's mixed photoacid generator for Uetani et al's photoacid generator, but even if it would have been prima facie obvious to do so, the evidence of superior results in Mr. Kanna's Declaration rebuts any prima facie case of obviousness and confirms the patentability of the present invention.

The resists reported in Mr. Kanna's Declaration were evaluated in the same manner described at pages 129-130 of the present specification. The results are shown in Table A of Mr. Kanna's Declaration, reproduced below. The symbols in Table A have the same meanings as described at pages 129-130 of the present specification:

Table A

	Crack	DE Resistance
Comparative Example a' (Example 1 of Uetani)	X	X
Example a (only the PAG of Example 1 of Uetani was replaced with PAG I-21/III-2 of Example IV-27 of Kodama et al)	O	O

As is evident from a comparison of these results, it is seen that, by using at least two species of the acid generator, a resin, and a mixed solvent, according to the present invention, excellent effects in terms of resistance to cracking and resistance to dry etching can be achieved. The resist of the present invention has superior resistance to cracking when a thermal flow process is employed to shrink the pattern. In addition, the resist of the invention has superior resistance to dry etching (DE). Mr. Kanna states that in his opinion, the superior results obtained with the positive resist composition of the present invention would have been unexpected to a person of ordinary skill in the art, in view of Uetani et al and Kodama et al. See page 3 of his Declaration.

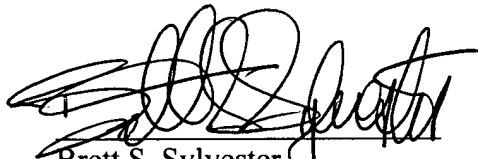
In view of the above, reconsideration and withdrawal of the § 103(a) rejection of claims 1-3 and 6-17 based on Uetani et al '070 in view of Kodama et al '415 are respectfully requested.

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No.: 10/802,808

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

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